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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,739	11/20/2001	Brendan Hinchey	DEKM:177US	9652

7590 04/10/2006

FULBRIGHT & JAWORSKI L.L.P.  
A REGISTERED LIMITED LIABILITY PARTNERSHIP  
SUITE 2400  
600 CONGRESS AVENUE  
AUSTIN, TX 78701

EXAMINER

WORLEY, CATHY KINGDON

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 04/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

09/989,739

Applicant(s)

HINCHEY ET AL.

Examiner

Cathy K. Worley

Art Unit

1638

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 20 March 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☒ The Notice of Appeal was filed on 20 March 2006. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☒ Applicant's reply has overcome the following rejection(s): The 102(e) rejections of claims 1 and 11 over LaRosa et al.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1 and 4-89.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_  
13. ☒ Other: See Continuation Sheet.

Continuation of 11. does NOT place the application in condition for allowance because: The rejections of the Office Action mailed on Dec. 16, 2005 are maintained..

Continuation of 13. Other: The claim amendment inserts "comprising from 400 to 2547 contiguous nucleotides" into part (b) of claim 1. This amendment adds a further limitation that any nucleic acid from the prior art must be at least 400 bp in length to anticipate the claimed nucleic acid, because any nucleic acid that is at least 400 bp in length comprises "400 to 2547 contiguous nucleotides".

The 112 1<sup>st</sup> written description rejections are maintained. The Applicant traverses on the grounds set forth in the previous response of Sept. 22, 2005. This is not persuasive, however, because the applicants are claiming a large genus of molecules and they have not described the structural features that are sufficient for the function of the molecules. For the reasons stated in the Office Action of Dec. 16, 2005, this rejection is maintained.

The 112 1<sup>st</sup> enablement rejections are maintained. The Applicant traverses on the groups set forth in the previous response of Sept. 22, 2005. This is not persuasive, however, because the applicants have only taught how to screen for and find new promoter molecules, they have not taught how to make and use the claimed promoters. For the reasons stated in the Office Action of Dec. 16, 2005, this rejection is maintained.

Furthermore, note that the region of instant SEQ ID NO:18 from 269-399 includes coding sequence from an exon of the glutamine synthetase gene. This indicates there may have been an artifact of cloning when SEQ ID NO:18 was isolated, and adds an additional level of unpredictability to methods of screening for new promoters contained within SEQ ID NO:18 or hybridizing to SEQ ID NO:18.

The 102(e) rejections over Muhitch et al. are maintained. The Applicant traverses on the grounds that the reference does not teach all of the limitations of the amended claim 1. This is not persuasive however, because Muhitch et al. teach a nucleic acid comprising at least 731 bp (see sequence search results), and this nucleic acid has 98% identity with SEQ ID NO:18 over a 258 bp. region, therefore it will hybridize under high stringency conditions. For these reasons, and the reasons stated in the Office Action of Dec. 16, 2005, this rejection is maintained.

The 103(a) rejections over Muhitch et al. in combination with a number of other prior art references are maintained. The Applicants traverse on the grounds that the Muhitch reference does not teach the nucleic acid of claim 1, and therefore the claims cannot be deemed obvious. This is not persuasive, however, because as noted above, Muhitch et al. do teach the nucleic acid recited in claim 1. For the reasons stated in the Office Action of June 20, 2005, this rejection is maintained.



ANNE KUBELIK, PH.D.  
PRIMARY EXAMINER